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EXAMINER

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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER R. LEFEBVRE,
CHRISTOPHER JAMES KONEN SR.,
MATTHEW JOSEPH KEANE, and
ELISSA BUDISCHAK

Appeal 2009-008215
Application 09/688,694
Technology Center 3600

Decided: June 16, 2010

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

An oral hearing was held on June 8, 2010.

STATEMENT OF THE CASE

Christopher R. Lefebvre, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 19, 22-29, and 32-38. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.¹

THE INVENTION

The invention relates to a method and system for retaining customer loyalty by “presenting incentives that are tailored to a particular customer and profitable to the provider.” Specification 1:6-7. “The present invention determines a set of incentives based on customer segmentation, card segmentation, call type as well as other factors.” Specification 5:5-7.

There are two independent claims; claim 19 to a method and claim 29 to a system. Claim 19 reproduced below, is illustrative of the subject matter on appeal.

19. A computer implemented method for providing one or more tailored incentives to a customer in response to a customer request, the computer implemented method comprising the steps of:
receiving a request from a customer, wherein the request is received by a provider or provider representative;

¹ Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Mar. 13, 2007) and Reply Brief (“Reply Br.,” filed Feb. 6, 2009), and the Examiner’s Answer (“Answer,” mailed Dec. 9, 2008).

retrieving account data associated with the customer in response to the request where the account data is displayed on a graphical user interface, wherein the account data is verified for the customer;

identifying the request as a request type from a list of predetermined request types, at a type module, where the request type identifies the customer's current situation;

identifying the customer as a customer segment, at a customer segment module, where the customer segment identifies the customer's past behavior;

identifying one or more incentives, at an incentive module, based on the request type, the customer segment and one or more profitability factors associated with the provider of the one or more incentives; and

offering the customer at least one of the identified one or more incentives for retaining the customer in response to the request, wherein the request is a request to terminate a relationship with the provider;

wherein the steps of identifying the request as a request type, identifying the customer as a customer segment and identifying one or more incentives are performed in response to the step of receiving a request from a customer; and

wherein the one or more incentives comprises at least one product or service offered by a financial institution.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

McCausland	US 5,822,410	Oct. 13, 1998
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Steve Gasner, *Forging a Link Between Retention and Profits*, Credit Card Management at 84 (Apr. 1992). (Gasner)

The following rejections are before us for review:

1. Claims 19, 22-29, and 32-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over McCausland and Gasner.

2. Claims 19 and 22-28 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

ISSUES

Has the Examiner shown that the claimed process is directed to nonstatutory subject matter?

Does McCausland disclose receiving a request from a customer, wherein the request is received by a provider or provider representative identifying the request as a request type from a list of predetermined request types, at a type module, where the request type identifies the customer's current situation ... *wherein the request is a request to terminate a relationship with the provider ?* (Claim 19).

FINDINGS OF FACT

The §103(a) rejection

Taking claim 19 as representative, the Examiner takes the position that McCausland discloses all the claim limitations but for “wherein the one or more incentives comprises at least one product or service offered by a financial institution” (the last clause in claim 19), for which Gasner is cited.

The Examiner found that

[i]t would have been obvious to a person skilled in the art at the time of the applicant's invention to modify McCausland to include providing products offered by a financial institution as retention incentives if McCausland's method was implemented to solve the retention problem for a financial services company instead of a cellular company, since at that time, financial services incentives would be more valuable retention tools to those customers rather than cellular services related incentives.

Answer 4-5.

The Appellants dispute the Examiner's position that McCausland discloses all the claim limitations except, "wherein the one or more incentives comprises at least one product or service offered by a financial institution". App. Br. 9. Consistent therewith, the Appellants identify limitations which the Appellants believe the Examiner has not shown to be disclosed as claimed. App. Br. 9.

One of the limitations identified as not having been addressed is a request to terminate a relationship with a provider. In the words of claim 19, the method comprises,

receiving a request from a customer, wherein the request is received by a provider or provider representative identifying the request as a request type from a list of predetermined request types, at a type module, where the request type identifies the customer's current situation ... *wherein the request is a request to terminate a relationship with the provider.*

(Claim 29 is a "system" claim providing for elements functioning in manner paralleling the steps in claim 19. *E.g.*, the system of claim 29 provides for a "type module for identifying the request as a request type from a list of predetermined request types, where the request type identifies the customer's current situation" and "an incentive module ... wherein the request is a request to terminate a relationship with the provider.")

According to the Examiner, McCausland discloses a request to terminate a relationship with a provider because it discloses "contract end is one of the problem factors for which customers call ORU's [organization representative users]", citing to the Abstract; col. 3, ll. 62-65; col. 11, ll. 40-46; col. 14, ll. 1-6; col. 15, ll. 1-4; and, Fig. 7. Answer 3. The Appellants disagree.

However, a customer either allows a contract to lapse thereby automatically terminating the contract or the customer will sign up for another term. Accordingly, there is nothing in the disclosure of McCausland that addresses “receiving a request from a customer ... wherein the request is a request to terminate a relationship with the provider.” The Office Action has failed to properly address this limitation.

App. Br. 10.

ANALYSIS

The §101 rejection

We will not sustain the rejection under §101.

The rejection simply restates the machine-or-transformation test for determining whether a claimed process is a statutory process under §101. *In re Bilski*, 545 F.3d 943, 961 (Fed. Cir. 2008) (en banc), *cert. granted*, 77 USLW 3442 (U.S. Jun. 1, 2009) (No. 08-964). But there is no further explanation. *See* Ans. 2 and 8-9. Further explanation was necessary to support a prima facie case of nonstatutory subject matter because a plain reading of the claim reveals that the process subject matter as claimed includes various apparatus limitations (*e.g.*, “computer implemented,” “type module,” “incentive module”). Because the Examiner has not addressed and explained why these various apparatus limitations, in the claims, are insufficient to tie the claimed method to a particular machine and thus (satisfying the machine prong of the *Bilski* test), a prima facie case of nonstatutory subject matter for the claimed subject matter under §101 has not been established in the first instance.

The §103(a) rejection

We have reviewed McCausland and find that we are in agreement with the Appellants.

The disclosure in McCausland which was relied upon as showing a request to terminate a relationship with the provider, does in fact describe a process for addressing churn, *i.e.*, the deactivation of an active customer account. The McCausland process seeks to ameliorate churn by identifying problems, for example, “Contract End” and “Dropped Calls” (*see* Table 2), indicative of customer dissatisfaction and performing responsive actions to address the problems (*see* col. 9, ll. 24-54). To that end, McCausland also describes procedures by which ORUs may propose specific offers to customers on behalf of the organization. *E.g.*, col. 10, ll. 36-48.

While McCausland does disclose “reactive” contacts by a customer with an ORU (*e.g.*, col. 3, ll. 61-65), no specific action, that the customer might take, is disclosed. Accordingly, McCausland does not expressly disclose a customer making a request to terminate a relationship with the provider as claimed. Even if one of ordinary skill in the art could infer requests to terminate a relationship with a provider given McCausland’s disclosure of “reactive” customer contacts (in light of the churn factors), the claimed subject matter requires more than simply a request to terminate a relationship with the provider. The claimed method calls for “*identifying the request as a request type from a list of predetermined request types, at a type module, where the request type identifies the customer's current situation ... wherein the request is a request to terminate a relationship with the provider.*” Even if one of ordinary skill in the art could infer a request is made with a provider, given McCausland’s disclosure of “reactive”

customer contacts, the prior art combination would not lead one of ordinary skill in the art to identify the request as a request type from a list of predetermined request types, at a type module, where the request type identifies the customer's current situation, notwithstanding that to meet the claim the request must not only be identified at a type module identifying the customer's current situation but must be a request to terminate the relationship with a provider.

For the foregoing reason, we find that a prima facie case of obviousness for the claimed subject matter has not been established.

DECISION

We reverse the §101 and §103(a) rejections.

ORDER

REVERSED

mev

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